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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,305	12/23/2003	Toshihiko Ina	64903-023	5559
7590 06/13/2008 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096				
EXAMINER BEAUCHAINE, MARK J				
ART UNIT 3653		PAPER NUMBER		
MAIL DATE 06/13/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/743,305

**Applicant(s)**

INA ET AL.

**Examiner**

MARK J. BEAUCHAINE

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,11-14,16,17,19 and 20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2,4,11-14,16,17,19 and 20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Patent Number 6,128,402 by Jones et al (“Jones”). The banknote handling device disclosed by Jones comprises money-in module 1 that receives banknotes from a customer, notification module 4 (see Figure 1a), a counterfeit collection box (see column 8, lines 50-53), discrimination module/counterfeit processing module 8 that carries out counterfeit detection and stores each banknote determined to be counterfeit into said counterfeit collection box (see Figure 1b and column 8, lines 36-43). Said counterfeit processing module further prohibits stored counterfeit banknotes from being returned to said customer (see column 8, lines 50-53).

Jones further discloses said notification module notifying a customer of the total amount of money received by said device including an amount of counterfeit notes and an amount of money settled in a transaction regardless of the counterfeit detection result, and an amount of money determined to be counterfeit (see column 11, lines 14-21).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Patent Number US 6,843,418 B2 by Jones et al ("Jones-2"). Jones fails to disclosed said notification module as presenting currency type and total information to a user. Jones-2 teaches a banknote handling device comprising a notification module that notifies a user of information for specifying a type and number of banknotes determined as counterfeit (see column 31, lines 36-67) for the purpose of permitting a user of said device to be aware of the condition of currency said user inserts into said device. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the notification module configuration of Jones-2 into the device of Jones for the purpose of permitting a user of said device to be aware of the condition of currency said user inserts into said device.

Jones fails to disclose an output module that outputs a form. Jones-2 teaches an output module that outputs a form describing currency information (see column 32, lines 1-6) for the purpose of providing a user of said device with a permanent record of a currency transaction. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the output module configuration of Jones-2 into the device of Jones for the purpose of providing a user of said device with a permanent record of a currency transaction.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Number 5,313,050 by Hiroki et al ("Hiroki") in view of Jones in view of Jones-2. The banknote handling device disclosed by Hiroki comprises money-in module 55, discrimination module/counterfeit processing module 70 that carries out counterfeit detection and stores banknotes in temporary storage box 38, and storage box 38 that stores genuine banknotes (see Figure 6 and column 6, lines 49-50). Hiroki further discloses control module 31 that temporarily keeps received notes in said temporary storage box, conveys genuine notes to said storage box, and returns genuine banknotes from said temporary storage box to said money-in module in response to a cancellation instruction from a customer (see column 7, lines 11-23).

Jones further discloses said notification module notifying a customer of the total amount of money received by said device including an amount of counterfeit notes and an amount of money settled in a transaction regardless of the counterfeit detection result, and an amount of money determined to be counterfeit (see column 11, lines 14-21).

Hiroki fails to disclose a counterfeit collection box. Jones teaches a counterfeit collection box that stores counterfeit banknotes and prohibits said banknotes from being returned to a customer (see Figure 1b, and column 8, lines 50-53) for the purpose of preventing counterfeit notes from being circulated. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the counterfeit collection box configuration of Jones into the device of Hiroki for the purpose of preventing counterfeit notes from being circulated.

Jones fails to disclosed said notification module as presenting currency type and total information to a user. Jones-2 teaches a banknote handling device comprising a notification

module that notifies a user of information for specifying a type and number of banknotes determined as counterfeit (see column 31, lines 36-67) for the purpose of permitting a user of said device to be aware of the condition of currency said user inserts into said device. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the notification module configuration of Jones-2 into the device of Jones for the purpose of permitting a user of said device to be aware of the condition of currency said user inserts into said device.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Jones-2. The banknote handling device disclosed by Jones comprises money-in module 1 that receives banknotes from a customer, notification module 4 (see Figure 1a), a counterfeit collection box (see column 8, lines 50-53), discrimination module/counterfeit processing module 8 that carries out counterfeit detection and stores each banknote determined to be counterfeit into said counterfeit collection box (see Figure 1b and column 8, lines 36-43). Said counterfeit processing module further prohibits stored counterfeit banknotes from being returned to said customer (see column 8, lines 50-53).

Jones further discloses said notification module notifying a customer of the total amount of money received by said device including an amount of counterfeit notes and an amount of money settled in a transaction regardless of the counterfeit detection result, and an amount of money determined to be counterfeit (see column 11, lines 14-21).

Jones fails to disclosed said notification module as presenting currency type and total information to a user. Jones-2 teaches a banknote handling device comprising a notification

module that notifies a user of information for specifying a type and number of banknotes determined as counterfeit (see column 31, lines 36-67) for the purpose of permitting a user of said device to be aware of the condition of currency said user inserts into said device. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the notification module configuration of Jones-2 into the device of Jones for the purpose of permitting a user of said device to be aware of the condition of currency said user inserts into said device.

Jones fails to disclose partition sheets. Jones-2 teaches said banknotes being bundled and separated by partition sheets 150 that are dispensed from a stacker (see Figure 1d and column 12, lines 51-67) for the purpose of separating groups of banknotes based on individual transactions. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the partition sheets of Jones-2 into the device of Jones for the purpose of separating groups of banknotes based on individual transactions.

Claims 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroki in view of Patent Number US 6,474,549 B2 by Katou et al ("Katou") in view of Jones. The banknote handling device disclosed by Hiroki comprises money-in module 55, safe 51, storage boxes 57 and 58 that are located within said safe and store banknotes classified by type, collection box 3 that is located outside of said safe, discrimination module 70 that carries out counterfeit detection, control module 31 that sorts banknotes based on results of said discrimination module (see Figure 6), and a management module that maps customer

information with banknote information related to a particular transaction (see column 4, lines 12-27).

Hiroki fails to disclose a setting module. Katou teaches a banknote handling device comprising setting module 10 that sets a banknote storage box to a collection box (see Figure 3 and column 21, line 63 through column 22, line 4) for the purpose of selectively storing banknotes classified by discrimination module 3. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the setting module of Katou into the device of Hiroki for the purpose of selectively storing banknotes classified by said discrimination module.

Hiroki fails to disclose a counterfeit banknote retaining box. Jones teaches a counterfeit collection box (see column 8, lines 50-53) that stores counterfeit banknotes and prohibits said banknotes from being returned to said customer (see Figure 1b; and column 8, lines 36-43 and 50-53) for the purpose of preventing counterfeit banknotes from being circulated. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the counterfeit banknote retention configuration of Jones into the device of Hiroki for the purpose of preventing counterfeit banknotes from being circulated.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 4, 11-14, 16, 17, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK J. BEAUCHAINE whose telephone number is (571)272-6934. The examiner can normally be reached on 8:00AM through 5:00PM Mondays through Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/  
Supervisory Patent Examiner, Art Unit  
3653

mjb